

REMARKS

I. Introduction

Claims 39-144 are pending in this application.

Claims 39-144 are rejected.

Applicant traverses these rejections based on the remarks set forth below. Applicant respectfully requests reconsideration and allowance of the pending claims.

II. Applicant's Reply to Claim Rejections Under 35 U.S.C. § 102

Claims 132-134, 137-138, 139-141, and 144

Claims 132-134, 137-141, and 144 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 5,636,276 to Brugger ("Brugger"). Applicant respectfully traverses.

Brugger is purportedly concerned with a device for the distribution of music information in digital form. *See, e.g.*, Brugger, Abstract; column 1, lines 1-15. The device includes a central memory device connected to a user terminal via a communication network. *See id.*, at column 3, line 65 – column 4, line 21; Fig. 1. The central memory device organizes the music information selected by the consumer for transmission in digital music information objects that may include a core and one or more additional layers. *See id.*, at column 4, lines 41-52; Figs. 1-3. The core includes the basic information for the music information object, while the layers are formed by the actual music information desired by the consumer. *See id.*, at column 4, lines 53-54; column 5, lines 1-2. The user terminal, which is based on a personal computer or a workstation, receives the music information object, processes and outputs it to audio or visual reproduction devices, such as a sound board, a monitor or a printer. *See id.*, at column 4, lines 15-17; column 5, lines 52-68; column 6, lines 26-35. To process the received music information object, the user terminal includes a decompression module, a decryption module, an administration module and an interpretation module. *See id.*, at column 4, line 52 – column 6, line 25. The interpretation

module interprets the additional layers containing the actual music information and conditions the music information into a form suitable for reproduction. *See id.*, at column 5, lines 56-59. Thus, in Brugger, the user terminal receives music information objects, extracts actual music information from the received objects and outputs the extracted music information to a reproduction device, such as a sound board, monitor, or printer. *Id.*

In contrast, applicant's invention, as specified in independent claims 132 and 139 recites a system that includes targeting logic for generating a targeted header based on information indicative of a player ID. The claimed system further recites "download logic for downloading the targeted header with associated content to a player." In rejecting these claims, the Examiner cites to a single passage in Brugger, contending that it teaches this feature. *See Office Action* dated June 14, 2005, at 3. Applicant respectfully disagrees. The excerpt cited by the Examiner states:

The music information object 12 is encrypted for transmission. The central memory device 2 has an encryption module 30 for this purpose. The encryption is based on the encryption table 24 which--as mentioned further above--is likewise included in the core 14, and is carried out, for example, using a pixel-matrix cryptography method.

See Brugger, at column 5, lines 45-50. Applicant respectfully points out that this passage merely deals with the concept of encrypting music information for transmission, rather than downloading a targeted header with associated content to a player as specified in applicants claims. Accordingly, Brugger fails to teach or suggest "download logic for downloading the targeted header with associated content to a player," as recited in independent claims 132 and 139 as the encryption of music information cannot be fairly analogized with downloading information to a player. Moreover, Brugger fails to show or suggest any action with respect to a

player ID. Thus, applicants respectfully submit claims 132 and 139 and the claims that depend therefrom, are allowable over Brugger for at least this reason

III. Applicant's Reply to Claim Rejections Under 35 U.S.C. §103

Claims 135-136 and 142-143

Claims 135-136 and 142-143 are rejected under 35 U.S.C. §103 (a) as being unpatentable over Brugger in view of U.S. Pat. No. 5,761,485 to Munyan ("Munyan"). Applicant respectfully traverses.

As explained above, one reason independent claims 132 and 139 are patentable over Brugger is because Brugger does not disclose "download logic for downloading the targeted header with associated content to a player." Munyan also fails to disclose this feature. Accordingly, claims 132 and 139 are patentable over the Examiner's proposed combination of Brugger and Munyan for at least the same reasons.

Moreover, the references themselves provide no motivation to combine the references as suggested by the Examiner. For example, the Examiner contends that:

"It would have been obvious for one of ordinary skill in the art to combine the teaching of Munyan with Brugger to provide a wireless mobile player device because it would have enabled the user to carry the device and viewed content on-the-go."

See Office action, at page 4. However, applicants note that this position merely highlights a possible perceived benefit that may result from a combination of references rather than any articulation of any reason or motivation to actually make the proposed combination. However, applicants point out that no motivation within the references themselves suggesting the proposed combination is actually provided. Thus, applicant respectfully submits that the Examiner's attempt to combine these two references is an application of impermissible hindsight reconstruction in an attempt to force a combination of otherwise unrelated references based upon

the teachings of applicant's disclosure. *See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887 (Fed. Cir. 1988). Nothing in the references suggests their combination. Moreover, substantial modification of Brugger would be required to accommodate the features of Munyan as proposed by the Examiner. No teaching is provided by either reference describing how to accomplish such modifications, further discouraging their combination.

Claims 39-53 and 55-131

Claims 39-53 and 55-131 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,230,173 to Ferrel et al. ("Ferrel") and in view of Munyan and Brugger. Applicant respectfully traverses.

Claims 39-53, and 55

Claims 39-53, and 55 specify "encrypting the digital information files using the player ID information." Munyan and Brugger, separately or in combination, fail to teach or suggest this feature. Munyan merely discusses coding a removable storage device to identify the device to the online bookstore and/or to a particular electronic book. Munyan fails to disclose any encryption of the content, let alone, encrypting the content using the player ID information. Although Brugger discusses encoding content using an encryption table, as explained above, completely absent from Brugger is any teaching or suggestion of "encrypting the digital information files using the player ID information."

The excerpt from Brugger cited by the Examiner states that "[t]he encryption is based on the encryption table ... and is carried out, for example, using a pixel-matrix cryptography method." *See* Brugger, at column 5, lines 45-50. This section of text merely deals with an encryption method used to encrypt the music information rather than being concerned with encryption based on player ID. In fact, the system in Brugger does not disclose a player to which

the encrypted digital information is later downloaded. Thus, neither Munyan nor Brugger teach or disclose this feature. Furthermore, in a prior Office Action, the Examiner notes that Ferrel does not teach this feature. *See* Office Action mailed June 14, 2005, at 5. Thus, claims 39-53, and 55 are patentable over Ferrel, Munyan, and Brugger.

Claims 56-58

Claims 56-58 specify a “computer system further including logic for downloading a portion or all of said targeted digital information files to said mobile device only if said mobile device corresponds to said player ID, said portion depending on storage space available in said mobile device.” Ferrel, Munyan, and Brugger fail to teach or suggest this feature as pointed out above. Thus, claims 56-58 are patentable over Ferrel, Munyan, and Brugger.

Claims 59-85

Claims 59-85 specify targeting the digital information using a targeted header containing information indicative of a player ID. As explained above, Ferrel, Munyan, and Brugger fail to teach or suggest this feature. Munyan discloses coding a removable storage device (a hardware component, rather than the associated content) to identify the device to the online bookstore and/or to a particular electronic book, and does not teach or suggest encoding the content itself. Brugger is merely concerned with encrypting the content for transmission; it does not teach or suggest targeting the digital information files using a targeted header containing information indicative of a player ID. Thus, claims 59-85 are patentable over Ferrel, Munyan, and Brugger.

Claims 86-131

Claims 86-131 specify targeting the programming content to a particular mobile device. Ferrel, Munyan, and Brugger fail to teach or suggest this feature as explained above. Thus,

applicants respectfully submit that claims 86-131 are patentable over Ferrel, Munyan, and Brugger.

Moreover, there is no motivation to combine these multiple references as suggested by the Examiner. With respect to a motivation to combine, the Examiner states:

“one of ordinary skill in the art would have been motivated to combine the teaching of Munyan and Brugger with Ferrel to have the library server maintain correspondence between digital file and player ID and to encrypt the files using the player ID prior to transmitting the content to the user because it would have improved the security of the content during transmission and reduced pirating of the digital information files once the user received the content.”

See Office action, at page 6. However, applicants note that this position merely highlights a possible perceived benefit that may result from a combination of references rather than any articulation of any reason or motivation to actually make the proposed combination. Applicants point out that no motivation within the references themselves suggesting the proposed combination is actually provided. Thus, applicant respectfully submits that the Examiner's attempt to combine these two references is an application of impermissible hindsight reconstruction in an attempt to force a combination of otherwise unrelated references based upon the teachings of applicant's disclosure. See *Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887 (Fed. Cir. 1988). Nothing in the references suggests their combination. Moreover, substantial modification of Brugger would be required to accommodate the features of Munyan and Ferrel as proposed by the Examiner. No teaching is provided by either reference describing how to accomplish such modifications, further discouraging their combination.

Claim 54

Claims 54 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ferrel in view of Munyan, Brugger, and U.S. Pat. No. 4,855,725 to Fernandez et al. ("Fernandez"). Applicant respectfully traverses.

Claim 54 recites encrypting digital information files using information indicative of a player ID. Ferrel, Munyan, Brugger, Fernandez fail to teach or suggest this feature. Thus, claim 54 is patentable over Ferrel, Munyan, Brugger, and Fernandez.

Moreover, there is no motivation to combine these multiple references as suggested by the Examiner. With respect to a motivation to combine, the Examiner states:

"one of ordinary skill in the art would have been motivated to combine the teaching of Munyan and Brugger with Ferrel ... because it would have improved the security of the content during transmission and reduced pirating of the digital information files once the user received the content."

"it would have been obvious for one of ordinary skill in the art to provide contents on a CDROM because it would have enabled the user to quickly access to certain information without having to download it from the library server."

See Office action, at page 12. However, applicants note that this position merely highlights a possible perceived benefit that may result from a combination of references rather than any articulation of any reason or motivation to actually make the proposed combination. Applicants point out that no motivation within the references themselves suggesting the proposed combination is actually provided. Thus, applicants respectfully submit that the Examiner's attempt to combine these two references is an application of impermissible hindsight reconstruction in an attempt to force a combination of otherwise unrelated references based upon the teachings of applicant's disclosure. See *Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887 (Fed. Cir. 1988). Nothing in the references suggests their combination.

Moreover, substantial modification of Brugger would be required to accommodate the features of Munyan, Ferrel and Fernandez as proposed by the Examiner. No teaching is provided by either reference describing how to accomplish such modifications, further discouraging their combination.

IV. Conclusion

For the foregoing reasons, Applicant respectfully submits that the invention as claimed is patentable over the references cited by the Examiner. Accordingly, reconsideration and allowance of pending claims 39-144 are respectfully requested. The Examiner is encouraged to contact Applicant's undersigned representative to discuss any matter that may expedite prosecution of this case.

Dated: 12/13/05

I hereby certify that the correspondence attached herewith is being deposited this date with the U.S. Postal Service as Express Mail Mailing Label No. EV446919759US, with sufficient postage addressed to the Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.

Tabitha Crosier 12/13/05
Tabitha Crosier Date

Respectfully submitted,

Victor Cole
Victor Cole
Reg. No. 56,331
BROWN RAYSMAN MILLSTEIN
FELDER & STEINER LLP
900 Third Avenue
New York, New York 10022
Tel : (212) 895-2000
Fax: (212) 895-2900